

Remarks

Applicant has carefully reviewed this Application in light of the Office Action dated November 6, 2003. Applicant appreciates the Examiner's consideration of the Application. Applicant respectfully requests reconsideration and allowance of all pending claims.

Applicant's Claims are Allowable over the Proposed *Wolfe-Yamada-Tittel* Combination

The Examiner rejects Claims 1-9, 11-12, 15-22, 25-26, 29-37, 39-40, and 43-50 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 6,282,517 B1 to Wolfe, et al. ("*Wolfe*") in view of U.S. Patent 6,336,100 B1 to Yamada ("*Yamada*"), Tittel, et al. "XML for Dummies" ("*Tittel*"), and Official Notice. Applicant respectfully disagrees.

wolfe
For example, the proposed *Wolfe-Yamada-Tittel* combination fails to teach, suggest, or disclose various limitations recited in independent Claim 1. In previous responses, Applicant detailed certain of the deficiencies in the teachings of *Wolfe* in disclosing Applicant's claims. Rather than burden the record by discussing those deficiencies again in the current Response, Applicant reiterates without specifically discussing those distinctions.

Additionally, the Examiner acknowledges, and Applicant agrees, that "*Wolfe* does not teach a second dealer identifier of a second dealer selected by the user from whom to purchase the tagged vehicle in the first dealer's inventory," as recited in Claim 1. (Office Action, Page 3) However, the Examiner proposes that *Yamada* does teach this limitation, stating that "*Yamada* teaches a system and method of online shopping wherein a user can select a product from a first merchant and can then select a second merchant from whom to purchase the product." (Office Action, Page 3) Applicant respectfully disagrees.

Yamada
Yamada is directed to providing "an online shopping system in which a customer can designate addresses or places where he or she wants to have goods delivered." (Column 1, Lines 19-22) For example, *Yamada* discloses, "As for the delivery information, the customer 3 selects his or her place of residence, a place (station) where the commodity is kept temporarily such as the 24-hour opened convenience store 9 closest to the place of residence of the customer 3 or a place of residence of another person 10 such as a friend of the customer 3 in

case of a gift from the customer 3 to the person 10." (Column 3, Lines 6-12) Apparently, the Examiner equates the convenience store or other station in *Yamada* to "the second dealer" recited in Applicant's Claim 1. However, the convenience store in *Yamada* is nothing more than *a delivery point* for a *purchase made from an online retailer*. According to *Yamada*, allowing the customer to designate *a delivery point* (e.g., the convenience store) that is not the customer's residence allows the customer to pick up the item *purchased from the online retailer* at any time, thus avoiding failed deliveries to the customer's residence. (See Column 4, Lines 4-14) Thus, *Yamada* fails to teach, suggest, or disclose "a second dealer identifier of a second dealer selected by the user from whom to purchase the tagged vehicle in the first dealer's inventory," as recited in Claim 1. *Wolfe* and *Tittel* fail to account for this deficiency of *Yamada*.)

In addition, the rejection of Claim 1 is improper because the Examiner has not shown the required teaching, suggestion, or motivation in *Wolfe*, *Yamada*, or in the knowledge generally available to those of ordinary skill in the art at the time of the invention to combine or modify *Wolfe* or *Yamada*. The rejected claims are allowable for at least this reason.

The M.P.E.P. sets forth the strict legal standard for finding obviousness based on a combination of references. According to the M.P.E.P., "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge [that was] generally available to one of ordinary skill in the art" at the time of the invention. M.P.E.P. 2143.01. The "fact that references can be combined or modified does not render the resultant combination [or modification] obvious unless the prior art also suggests the desirability of the combination" or modification. *Id.* (emphasis in original).

The governing Federal Circuit case law makes this strict legal standard even more clear.¹ According to the Federal Circuit, "a showing of a suggestion, teaching, or motivation to combine . . . prior art references is an essential component of an obviousness holding." *In re*

Sang-Su Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25 (Fed. Cir. 2000)). "Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved." *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). However, the "range of sources available . . . does not diminish the requirement for actual evidence." *Id.* In *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that proper evidence of a teaching, suggestion, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999 (quoting *W.L. Gore & Assoc., Inv. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)) (emphasis added) (citations omitted).² Even a determination that it would have been obvious to one of ordinary skill in the art at the time of the invention to try the proposed combination is not sufficient to establish obviousness. *See In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988).

✎ With regard to the proposed *Wolfe-Yamada* combination, the Examiner indicates that "Yamada teaches a system and method of online shopping wherein a user can select a product from a first merchant and can then select a second merchant from whom to purchase the product." (Office Action, Page 3) The Examiner then summarily states, "Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to

¹ Note M.P.E.P. 2145 X.C. ("The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.").

² *See also In Re Jones*, 958 F.2d 347, 351 (Fed. Cir. 1992) ("Conspicuously missing from this record is any evidence, other than the PTO's speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at" the claimed invention.).

incorporate the teachings of Yamada into the system and method of Wolfe. One of ordinary skill in the art would have been motivated to do so in order to allow a customer to take possession of a product from a convenient location, as taught by Yamada." (Office Action, Pages 3-4) First, as discussed above with reference to the obviousness rejection, Applicant disputes that *Yamada* discloses that a user "can then select a second merchant *from whom to purchase the product*," as proposed by the Examiner. Second, *Wolfe* never mentions the desirability of making deliveries of any sort, such as those discussed in *Yamada*. Additionally, nowhere does *Yamada* mention using its system in a system such as the one disclosed in *Wolfe* in which a vehicle buyer inputs desired information about a vehicle into a Data Center System and that information is communicated by the Data Center System to one or more dealers as a purchase request. Thus, Applicant respectfully submits that the Examiner's proposed combination of *Wolfe* with *Yamada* appears to be merely an attempt, with the benefit of hindsight, to reconstruct Applicant's claims and is unsupported by the teachings of *Wolfe* and *Yamada*. The mere fact that one or more advantages may be gained by combining the references is not enough according to the M.P.E.P. and applicable case law.

All of Applicant's arguments are without prejudice or disclaimer. Additionally, Applicant has merely discussed example distinctions from the *Wolfe*, *Yamada*, and *Tittel* references. Other distinctions may exist, and Applicant reserves the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. The example distinctions discussed by Applicant are sufficient to overcome the obviousness rejection.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of Claim 1 and its dependent claims.

✕ Applicant respectfully submits that independent Claims 17, 31, and 45 are allowable at least for analogous reasons to those discussed above with reference to Claim 1. In addition, Claims 17, 31, and 45 recited further patentable distinctions over the proposed *Wolfe-Yamada-Tittel* combination.

For example, with respect to independent Claim 31, the proposed combination fails to teach, suggest, or disclose, at a minimum, "generating a computerized search reply message in response to processing the search request message, the search reply message including a list of products matching at least one search criteria, including products *in-inventory* at the retailer identified by the retailer identifier as well as products *in-transit* to the retailer and *in-process* products." The delivery points of *Yamada* have nothing to do with "the search reply message including a list of products matching at least one search criteria, including products *in-inventory* at the retailer identified by the retailer identifier as well as products *in-transit* to the retailer and *in-process* products," as recited in Claim 31. Indeed, it does not appear that the Examiner indicated any portions of *Wolfe*, *Yamada*, or *Tittel*, which purportedly disclose "products *in-inventory* at the retailer identified by the retailer identifier as well as products *in-transit* to the retailer and *in-process* products," as recited in Claim 31.

As another example, with respect to independent Claim 45, the proposed combination fails to teach, suggest, or disclose, at a minimum, "searching an inventory database for a product matching the product configuration data, the inventory database containing products *on the order bank, in-production, in-transit, and in-inventory*." The delivery points of *Yamada* have nothing to do with "products *on the order bank, in-production, in-transit, and in-inventory*," as recited in Claim 45. Indeed, it does not appear that the Examiner indicated any portions of *Wolfe*, *Yamada*, or *Tittel*, which purportedly disclose "products *on the order bank, in-production, in-transit, and in-inventory*," as recited in Claim 45.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of independent Claims 17, 31, and 45, and their respective dependent claims.

✎ The Examiner rejects Claims 13-14, 27-28, and 41-42 under 35 U.S.C. §103(a) as being unpatentable over *Wolfe* in view of *Yamada* and further in view of Korth et al. "Database System Concepts" ("*Korth*"). The Examiner rejects Claims 10, 24, and 38 under 35 U.S.C. §103(a) as being unpatentable over *Wolfe* in view of *Yamada* and further in view of St. Laurent "Cookies" ("*St. Laurent*"). Claims 10 and 13-14 (which depend from independent Claim 1), Claims 24 and 27-28 (which depend from independent Claim 17), and Claims 38 and 41-42

(which depend from independent Claim 31) depend from allowable independent Claims and are allowable for at least this reason. For at least this reason, Applicant respectfully requests reconsideration and allowance of Claims 10, 13-14, 24, 27-28, 38, and 41-42.

Applicant's Claims are Allowable Over the Proposed *Berent-Yamada-Tittel* Combination

The Examiner rejects Claims 1-2, 17, 31-33, 45, and 47 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 5,774,873 to Berent, et al. ("*Berent*") in view of *Yamada* and in further view of *Tittel*. Applicant respectfully disagrees.

For example, with respect to Claim 1, *Berent* fails to teach, suggest, or disclose, at a minimum, a processor operable to "receive a computerized search request message including . . . at least one search criteria . . . and a weighting of each criterion." The portions of *Berent* cited by the Examiner as teaching this limitation merely disclose a stock locator for an online vehicle auction. (Column 7, Lines 52-54) The user can select a Vehicle Search command to select from predefined menus of make, model, and year of vehicles. (Column 7, Lines 64-67) Following selection of the vehicles to be located, a listing of vehicles corresponding to the search criteria appear, along with motor vehicle auction information associated with those vehicles. (Column 8, Lines 1-4) However, nowhere do the cited portions of *Berent* teach, suggest, or disclose a processor operable to "receive a computerized search request message including . . . at least one search criteria . . . and a weighting of each criterion," as recited in Claim 1.

Additionally, the Examiner acknowledges, and Applicant agrees, that "*Berent* does not teach a second dealer identifier of a second dealer selected by the user from whom to purchase the tagged vehicle in the first dealer's inventory," as recited in Claim 1. (Office Action, Page 11) However, the Examiner proposes that *Yamada* does teach this limitation, stating that "*Yamada* teaches a system and method of online shopping wherein a user can select a product from a first merchant and can then select a second merchant from whom to purchase the product." (Office Action, Page 3) Applicant respectfully disagrees.

As discussed above with reference to the proposed *Wolfe-Yamada* combination, the Examiner apparently equates the convenience store or other station in *Yamada* to "the second dealer" recited in Applicant's Claim 1. However, the convenience store in *Yamada* is nothing more than *a delivery point for a purchase made from an online retailer*. According to *Yamada*, allowing the customer to designate *a delivery point* (e.g., the convenience store) that is not the customer's residence allows the customer to pick up the item *purchased from the online retailer* at any time, thus avoiding failed deliveries to the customer's residence. (See Column 4, Lines 4-14) Thus, *Yamada* fails to teach, suggest, or disclose "a second dealer identifier of a second dealer selected by the user *from whom to purchase* the tagged vehicle in the first dealer's inventory," as recited in Claim 1. *Berent* and *Tittel* fail to account for this deficiency of *Yamada*.

In addition, the rejection of Claim 1 is improper because the Examiner has not shown the required teaching, suggestion, or motivation in *Berent*, *Yamada*, or in the knowledge generally available to those of ordinary skill in the art at the time of the invention to combine or modify *Berent* or *Yamada*. The rejected claims are allowable for at least this reason.

Applicant reiterates the strict legal standard discussed above regarding combining or modifying references. With regard to the proposed *Berent-Yamada* combination, the Examiner indicates that "Yamada teaches a system and method of online shopping wherein a user can select a product from a first merchant and can then select a second merchant from whom to purchase the product." (Office Action, Page 11) The Examiner then summarily states, "Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Yamada into the system and method of Berent. One of ordinary skill in the art would have been motivated to do so in order to allow a customer to take possession of a product from a convenient location, as taught by Yamada." (Office Action, Page 11) First, as discussed above with reference to the obviousness rejection, Applicant disputes that *Yamada* discloses that a user "can then select a second merchant from whom to purchase the product," as proposed by the Examiner. Second, in describing its online vehicle auction system and method, *Berent* never mentions the desirability of making deliveries of any sort, such as those discussed in *Yamada*. Additionally, nowhere does *Yamada*

mention using its system in any sort of online auction environment such as the one disclosed in *Berent*. Thus, Applicant respectfully submits that the Examiner's proposed combination of *Berent* with *Yamada* appears to be merely an attempt, with the benefit of hindsight, to reconstruct Applicant's claims and is unsupported by the teachings of *Berent* and *Yamada*. The mere fact that one or more advantages may be gained by combining the references is not enough according to the M.P.E.P. and applicable case law.

All of Applicant's arguments are without prejudice or disclaimer. Additionally, Applicant has merely discussed example distinctions from the *Berent*, *Yamada*, and *Tittel* references. Other distinctions may exist, and Applicant reserves the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. The example distinctions discussed by Applicant are sufficient to overcome the obviousness rejection.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of Claim 1 and its dependent claims.

Applicant respectfully submits that independent Claims 17, 31, and 45 are allowable at least for analogous reasons to those discussed above with reference to Claim 1. In addition, Claims 17, 31, and 45 recited further patentable distinctions over the proposed *Berent-Yamada-Tittel* combination.

For example, with respect to independent Claim 31, the proposed combination fails to teach, suggest, or disclose, at a minimum, "generating a computerized search reply message in response to processing the search request message, the search reply message including a list of products matching at least one search criteria, including products *in-inventory* at the retailer identified by the retailer identifier as well as products *in-transit* to the retailer and *in-process* products." The delivery points of *Yamada* have nothing to do with "the search reply message including a list of products matching at least one search criteria, including products *in-inventory* at the retailer identified by the retailer identifier as well as products *in-transit* to the retailer and *in-process* products," as recited in Claim 31. Indeed, it does not appear that the Examiner indicated any portions of *Berent*, *Yamada*, or *Tittel*, which purportedly disclose

"products *in-inventory* at the retailer identified by the retailer identifier as well as products *in-transit* to the retailer and *in-process* products," as recited in Claim 31.

As another example, with respect to independent Claim 45, the proposed combination fails to teach, suggest, or disclose, at a minimum, "searching an inventory database for a product matching the product configuration data, the inventory database containing products *on the order bank, in-production, in-transit, and in-inventory*." The delivery points of *Yamada* have nothing to do with "products *on the order bank, in-production, in-transit, and in-inventory*," as recited in Claim 45. Indeed, it does not appear that the Examiner indicated any portions of *Berent*, *Yamada*, or *Tittel*, which purportedly disclose "products *on the order bank, in-production, in-transit, and in-inventory*," as recited in Claim 45.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of independent Claims 17, 31, and 45, and their respective dependent claims.

Conclusion

Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for other reasons clearly apparent, Applicant respectfully requests reconsideration and allowance of all pending Claims.

Although no fees are believed due, the Commissioner is hereby authorized to charge any fees necessary for advancement of the prosecution of this case or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact its attorney at the number provided below.

Respectfully submitted,
BAKER BOTTS L.L.P.
Attorneys for Applicant



Samir A. Bhavsar
Reg. No. 41,617

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CORRESPONDENCE ADDRESS:

Baker Botts L.L.P.
2001 Ross Avenue, 6th Floor
Dallas, TX 75201-2980
Phone: (214) 953-6581